

REMARKS

I. Summary of Office Action

Claims 4-8, 14-18, and 21-30 were pending in the application.

Claims 26-28 were rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Claims 4, 8, and 21-25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 4, 8, 14, 18, 24, 25, 29, and 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brenner et al. U.S. Patent No. 5,830,068 (hereinafter "Brenner").

Claims 21-23 and 26-28 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Brenner.

II. Summary of Applicants' Reply

Applicants have amended claims 4, 14, 21, and 26 to more particularly define the invention.

The rejection of applicants' claims is respectfully traversed.

III. Applicants' Reply to the § 112 Rejection

Claims 26-28 were rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants have amended claim 26 to clarify that the control circuitry is the same circuitry specified in claim 14.

Applicants respectfully request, therefore, that the 35 U.S.C. § 112 of claims 26-28 be withdrawn.

IV. Applicants' Reply to the § 101 Rejection

Claims 4, 8, and 21-25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have amended independent claim 4 to positively tie the claim to the wagering terminal and user interface that receives the indication of a wagering preference from the first user. Applicants respectfully request, therefore, that the 35 U.S.C. § 101 of claims 4, 8, and 21-25 be withdrawn.

V. Applicants' Reply to the 102(b) Rejection

A. Overview of Applicants' Claimed Invention

Independent claims 4 and 14, as amended, are directed toward a method and system of providing a user interface for interactive wagering. An indication of a first wagering preference is received from a first user. The first wagering preference is stored during a first user session. A first user is identified in at least one first subsequent user session. The stored first wagering preference is then used as a default selection in subsequent wagers in at least one of the first subsequent user sessions in response to identifying the first user. The subsequent wagers are associated with at least a track selection, a race selection, a bet type selection, a bet amount selection, and a horse selection. The user is also provided with an opportunity to change the default selection for at least one of the subsequent wagers from the default selection

to another selection.

The Examiner alleges that all these claimed features are shown or suggested by Brenner. Applicants respectfully disagree.

B. Brenner Does Not Show or Suggest
Storing a Wagering Preference in a First User
Session and Using that Stored Wagering
Preference in a Subsequent User Session

The Examiner maintains his position that Brenner's "duplicate a wager" and "more bets same race" functions can be considered saved player preferences. See Office Action, pp. 5-6. The Examiner also maintains his position that these saved player preferences may be saved in one wagering session and used as a default selection in another, different wagering session. *Id.* For the reasons set forth in applicants' February 5, 2009 Reply to Final Office Action and February 6, 2008 Reply to Office Action, applicants disagree and submit that this characterization of Brenner is unreasonable especially in light of applicants' specification. As the Examiner is aware, claims must be "given their broadest reasonable interpretation consistent with the specification." MPEP § 2111; see *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

In order to advance prosecution, however, applicants have amended independent claims 4 and 14 to clarify that the wagering preference is created and saved in a first user session and then used in subsequent user sessions. A user session is

terminated when the user quits the interactive wagering interface.

In Brenner, the settings from the "duplicate a wager" and "more bets same race" functions are used during the creation of the next wager. See Brenner col. 12, lines 27-51. The user might select one of these buttons more than one time, but each time the user presses the button the selections from the *immediately preceding* wager are used. After the user quits the interactive wagering interface and exits the user session, additional wagers using that same stored wagering preference are impossible. Rather, the user must manually create a new wager and with new selections because no immediately preceding wager for that user exists.

Applicants' claimed invention, therefore, patentably improves upon Brenner by storing the user's wagering preference in one user session and using that preference in subsequent wagers in subsequent user sessions (in response to the user that saved the wagering preference being identified). As such, the user's default wagering preferences may be accessed and used even after, for example, the wagering interface is reinitialized and the user is reauthorized. See specification, ¶¶ 0157-0164.

For at least the foregoing reasons, applicants submit that independent claims 4 and 14 are allowable over Brenner. Dependent claims 8 and 18 and 21-30, which include all the limitations of one of independent claims 4 and 14, are allowable for at least the same reasons. Applicants respectfully request, therefore, that the rejection of claims 4, 8, 14, 18, and 21-30 be withdrawn.

C. Brenner Does Not Show or Suggest
Using a Stored Wagering Preference
in Response to Identifying a User

Even assuming, *arguendo*, that Brenner did show a stored wagering preference that could be used in different user sessions, there is no showing or suggestion in Brenner of using this stored preference as any default selection in response to identifying the user, as recited by both independent claims 4 and 14. Although Brenner does describe the use of personal identification codes and smart cards to authorize users and for security (see, for example, Brenner, col. 4, ll. 43-56 and col. 8, ll. 41-56), Brenner is silent as to identifying users for use in setting default selections for subsequent wagers by that user. Rather, the "duplicate a wager" and "more bets same race" functions simply use the selections from the immediately preceding wager for subsequent wagers. See Brenner, col. 12, ll. 27-50. These functions are not performed "in response to identifying" any user.

As such, independent claims 4 and 14 patentably improve upon the teachings of Brenner by using the stored first wagering preference as a default selection in subsequent wagers in the at least one first subsequent wagering session in response to identifying a user. For example, a user may identify himself or herself to the wagering interface by inputting a username/password combination or PIN. In response to identifying the user, a default selection of, for example, a race, track, runner, bet amount, or bet type may be automatically used in subsequent wagers. Brenner (and the other

prior art of record) does not show or suggest this claimed functionality.

For at least the foregoing reasons, applicants submit that independent claims 4 and 14 are allowable over Brenner. Dependent claims 8 and 18 and 21-30, which include all the limitations of one of independent claims 4 and 14, are allowable for at least the same reasons. Applicants respectfully request, therefore, that the rejection of claims 4, 8, 14, 18, and 21-30 be withdrawn.

III. Applicants' Reply to the 103(a) Rejection

Dependent claims 21-23 and 26-28 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Brenner. These claims are allowable at least because they depend from one of allowable independent claims 4 and 14. These claims are also allowable for additional reasons.

As admitted by the Examiner, Brenner does not explicitly disclose receiving an indication from a second user of a second wagering preference, storing the second wagering preference during a second wagering session, identifying the second user in at least one second subsequent wagering session, and in response to identifying the second user, using the stored second wagering preference as a default selection in subsequent wagers in the at least one second subsequent wagering session, as recited by dependent claims 21 and 26. As also admitted by the Examiner, Brenner fails to explicitly disclose that the first and second users are different users, as recited by dependent claims 23 and 28, or that the first wagering

preference and second wagering preference are different wagering preferences, as recited by dependent claims 22 and 27. See Office Action, p. 9.

According to the Examiner, however, all of these dependent features are obvious in view of Brenner because Brenner "is capable of allowing different users to play" and "each registered user must log in using [his/her] personal identification code in order to play." *Id.* The Examiner attempts to bolster his argument with the assertion that it would have been obvious to recognize that the user terminal of Brenner could be used by different people in the same residence, such as family members or roommates, who play the game differently. *Id.* This, according to the Examiner, renders applicants' dependent claims 21-23 and 26-28 obvious. *Id.*

Applicants respectfully disagree and submit that the Examiner has failed to carry his burden in establishing a *prima facie* case of obviousness.

First, as the Examiner seems to admit, none of the prior art references show or suggest the claimed features recited by dependent claims 21-23 and 26-28. Yet, as the Examiner is aware, for an Office Action to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Second, the Examiner's logic is misguided. Just because a user terminal allows different users to use the terminal, this fact alone does not mean that it would have been obvious for the different users to set up different wagering

preferences for use in subsequent wagers in subsequent wagering sessions. Rather, as described above, the Examiner's interpretation of a stored wagering preference is unreasonable and inconsistent with applicants' specification. The § 103(a) rejection takes this unreasonable interpretation even further by arguing it would be applicable to more than one user and more than one preference. There is simply no support for the Examiner's contention that it would have been obvious from Brenner to identify a second user, and in response to identifying that second user, using that user's stored wagering preference as a default selection in subsequent wagers. There is similarly no support for the Examiner's contention that the two wagering preferences may be different wagering preferences. As described above, the "duplicate a wager" and "more bets same race" options, which the Examiner relies on to show stored wagering preferences, merely copy the previous wager or race information into a new wager for the same user. This is markedly different than receiving an indication from two users of two different wagering preferences, identifying the users in a subsequent wagering session, and in response to identifying a user, using the identified user's stored wagering preference as the default selection in subsequent wagers in subsequent wagering sessions.

For at least these additional reasons, dependent claims 21-23 and 26-28 are allowable over Brenner. Applicants respectfully request, therefore, that the rejection of claims 21-23 and 26-28 be withdrawn.

Application Serial No. 09/729,484
Office Action dated: 04/03/2009
Reply to Office Action dated: 10/05/2009

V. Conclusion

In view of the foregoing, claims 4, 8, 14, 18, and 21-30 are in condition for allowance. The Office Action has withdrawn claims 5-7 and 15-17 from consideration as directed to a non-elected species. Applicants respectfully request that these claims be rejoined because the generic claims (i.e., independent claims 4 and 14) are in condition for allowance. This application is therefore in condition for allowance.

Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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